



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,017	10/18/2000	Haruo Kamei	550718.077	4521

27805 7590 12/10/2004
THOMPSON HINE L.L.P.
2000 COURTHOUSE PLAZA , N.E.
10 WEST SECOND STREET
DAYTON, OH 45402

EXAMINER

OJINI, EZIAMARA ANTHONY

ART UNIT	PAPER NUMBER
----------	--------------

3723

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,017

Applicant(s)

KAMEI, HARUO

Examiner

Anthony Ojini

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,9,11,13,14 and 16-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,9,11,13,14 and 16-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3723

DETAILED ACTION

Applicant's cancellation of claims 1-6,8,10,12,15 filed 11/12/04 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 7,9,11,13,14,16-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, line 4, the expression "said abrasive foam resin" lacks antecedent basis.

In claim 22, line 2, change the term "polurality" to --- plurality-----.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7,9,11,13,14,16-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nokubi et al (EP 0 798 081 A2) in view of Kitajima et al. (5,495,844) and Kimura et al. (4,753,838).

Art Unit: 3723

With respect to claims 7,9,23, Nokubi et al. (EP 0 798 081 A2) disclose an abrasive material comprising a core (1) and a polishing layer, wherein the polishing layer comprises abrasive particles (2), wherein the core is made of porous synthetic resin and the abrasive particle is in the form of granules that is inherently capable for spray application to a surface of a work (see col. 2, lines 31-39 & fig. 1).

Nokubi et al. fail to disclose wherein the polishing layer comprises a flexible layer formed on the surface of the core and the abrasive.

Kimura et al. disclose a polishing sheet comprising flexible synthetic resin layer sheet (1).

Kitajima et al. disclose an abrasive material comprising a core (10) and a polishing layer (14), wherein the polishing layer comprises a bonding layer made of water-soluble epoxy resin formed on the surface of the core and abrasive.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Nokubi et al. with polishing layer comprises a flexible layer formed on the surface of the core and the abrasive in view of Kitajima et al and kimura et al. so as to retain the abrasive particles on the core during polishing process.

With respect to claims 11,13, Nokubi et al. fail to disclose wherein the polishing layer comprises multiple layers.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Nokubi et al. with the polishing layer comprising multiple layers **so as to so as have sufficient resiliency**, since it has been

Art Unit: 3723

held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With respect to claims 14,16,17,18, Nokubi et al. to fail to disclose wherein a flexible layer comprises an emulsion adhesive, the abrasive particles are attached onto the emulsion adhesive and the emulsion adhesive is subjected to a heating and drying process; and wherein the polishing layer comprising an emulsion adhesive mixed with abrasive particles is applied to the core and subjected to a heating and drying process. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Nokubi et al. with an abrasive material wherein a flexible layer comprises an emulsion adhesive, the abrasive particles are attached onto the emulsion adhesive and the emulsion adhesive is subjected to a heating and drying process; and wherein the polishing layer comprising an emulsion adhesive mixed with abrasive particles is applied to the core and subjected to a heating and drying process **so as to retain the abrasive particles on the core**, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (e.g. retaining abrasive particles onto the core) as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

With respect to claims 19, 26, Nokubi et al. disclose adhesive made selected from synthetic resin (a form of rubber latex), (see col. 4, lines 30-35).

With respect to claims 20,21,24, Nokubi et al. fail to disclose the optimum range as claimed by the applicant.

Art Unit: 3723

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Nokubi et al with the optimum range as claimed by the applicant **so as to create a recess for holding therein a polishing slurry**, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With respect to claim 22, Nokubi et al. disclose an abrasive material comprising a plurality of granules having an internal core (1) and an external polishing layer, wherein the polishing layer comprises abrasive particles that is inherently capable for spray application to a surface of a work (see column 2, lines 31-39 & fig. 1).

Nokubi et al. fail to disclose wherein the polishing layer comprises a flexible layer formed on the surface of the core and the abrasive, said flexible layer substantially surrounding the internal core.

Kimura et al. disclose a polishing sheet comprising flexible synthetic resin layer sheet.

Kitajima et al. disclose an abrasive material comprising a core (10) and a polishing layer (14), wherein the polishing layer comprises a bonding layer (15) made of water-soluble epoxy resin that substantially surrounds the core.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Nokubi et al. with polishing layer comprises a flexible layer substantially surrounding the internal core in view of Kitajima et al and kimura et al. so as to retain the abrasive particles on the core during polishing process.

With respect to claim 25, Nokubi et al. fail to disclose emulsion adhesive flexible layer.

Art Unit: 3723

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Nokubi et al. with emulsion adhesive flexible layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (**e.g. retaining abrasive particles onto the core**) as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Response to Amendment

Applicant's arguments filed 11/12/04 have been fully considered but they are not persuasive.

Applicant argues that "a prima facie case of obviousness has not been established with respect to the pending application because the cited references fail to provide the requisite motivation to combine and modify the references to arrive at the present invention". However, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kimura et al. disclose concept of a polishing sheet comprising flexible synthetic resin

Art Unit: 3723

layer sheet. Nokubi et al. also disclose the concept of an abrasive material comprising a core and a polishing layer, wherein the polishing layer comprises abrasive particles, wherein the core is made of porous synthetic resin and the abrasive particle is in the form of granules except wherein the polishing layer comprises a flexible layer formed on the surface of the core and the abrasive. Kimura et al. disclose a polishing sheet comprising flexible synthetic resin layer sheet; and Kitajima et al. disclose an abrasive material comprising a core and a polishing layer, wherein the polishing layer comprises a bonding layer made of water-soluble epoxy resin formed on the surface of the core and abrasive.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Nokubi et al. with polishing layer comprises a flexible layer formed on the surface of the core and the abrasive in view of Kitajima et al. and kimura et al. so as to retain the abrasive particles on the core during polishing process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Ojini whose telephone number is 571 272 4492. The examiner can normally be reached on 7 to 4 Tuesday-Friday with every other Monday off.

Art Unit: 3723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272 4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AO
11/30/04

A handwritten signature in cursive script, appearing to read "AO", followed by a flourish.